

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)	
HAUGLAND ET AL.)	Attorney Docket No:
)	81301
Serial No. 09/513,845)	
)	
Filing Date: FEBRUARY 25, 2000)	Art Unit: 2153
)	
For: MASS GENERATION OF VIRTUAL)	Date Submitted:
SERVERS, VIRTUAL WEB SITES AND)	
VIRTUAL WEB OBJECTS)	<u>January 23, 2007</u>
)	

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to an Examiner's Office Action of October 23, 2006, which responded to Appellant's Appeal Brief filed June 26, 2006. That Office Action contained a new ground of rejection but is otherwise substantially identical to the rejections previously asserted in the Final Rejection.

Applicant respectfully requests that the Appeal be maintained and submits this Reply Brief under 37 C.F.R. § 41.39(b) and MPEP § 1207.03 IV.

This Reply Brief contains all of the material of Appellant's Appeal Brief dated June 26, 2006 and, in addition, responds to the new ground of rejection. If any extension and/or other fee is required, authorization is given to charge deposit account 01-0484.

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Real Party in Interest

The inventors are the real party in interest, namely Henry Haugland and Linda Wollschlager.

Related Appeals and Interferences

The undersigned is not aware of any appeals or interferences which would effect or be affected by a decision in this appeal.

Status of the Claims

Claims 1-33, 42, 43, 45-53, 62 and 63 remain in the application. Claims 34-41, 44, 54-61 and 64-78 have been cancelled because they were withdrawn from consideration as directed to a non-elected invention. Claims 1-33, 42, 43, 45-53, 62 and 63 stand rejected. The rejection of all claims, mainly 1-33, 42, 43, 45-53, 62 and 63 has been appealed.

Status of Amendments

No amendments have been filed subsequent to the Final rejection of January 24, 2006.

Summary of Claimed Subject Matter

As set forth more specifically hereinafter in this section, the invention is directed to techniques for advertising or otherwise inducing activity by a target (page 17 of the specification, line 17) of the advertising, often called a "contact", at a server (page 10 of the specification, lines 12-13) on a network (e.g. Figure 1, item 122, 128) by including the contact name within the resource location descriptions.

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One advantage of techniques from the present invention is that the promoter (page 7 of the specification, line 15, e.g. wholesaler, retailer, advocate, charity or political entity) can provide a large number of web sites (e.g., page 10 of the specification, lines 12-13) one for each contact (e.g., customer, potential customer, viewer, supporter or voter) whom the promoter has identified. Each web site can have a domain name that prominently displays the contact's name (e.g. Figure 5A, columns 552, 554). The psychological benefit to the contact of finding a web site devoted to the contact and with the contacts name as part of the domain name conditions the contact favorably and increases the chances that the results sought by the promoter will be achieved.

In the following list of independent claims, references to the specification and drawings should not be construed as an argument for patentability that could be used against Applicant as an estoppel, but rather, the examples are provided as a convenience to the Board of Patent Appeals and Interferences in understanding the invention and in complying with the new rule on Appeal Briefs.

Independent Claims:

Claim 1 A method for inducing a contact [e.g. a target of a promoter] to invoke a resource [e.g. files or service, e.g. page 6, lines 13-18] prepared by a promoter [e.g. a person desiring to reach targets, e.g. page 7, line 15] on a network [e.g. network 210 of Figure 2], the method comprising:

generating a resource location description for the resource by the promoter, the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] including a name of the contact [e.g. Figure 5A, columns 552, 554];

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providing access to the resource at a location on the network according to the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21]; and

notifying the contact [e.g. page 11, lines 5-6] about the resource location description for the resource [e.g. step 360 of Figure 3B].

Claim 31 A method for inducing a contact [e.g. a target of a promoter] to visit a web site prepared by a promoter [e.g. a person desiring to reach targets, e.g. page 7, line 15], the method comprising:

generating a host name for the web site [e.g. a server running on a device, e.g. page 10, lines 12-13] by the promoter [e.g. a person desiring to reach targets, e.g. page 7, line 15], the host name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3; e.g. Figure 5A, column 562] including a name of the contact [e.g. Figure 5A, columns 552, 554];

notifying the contact [e.g. page 11, lines 5-6] of the host name for the website [e.g. a server running on a device, e.g. page 10, lines 12-13]; and

configuring a web server [e.g. a server running on a device, e.g. page 10, lines 12-13] at the web site [e.g. a server running on a device, e.g. page 10, lines 12-13] to process a request including the host name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3; e.g. Figure 5A, column 562].

Claim 42 A method of promoting a cause to a contact [e.g. a target of a promoter], the method comprising:

including a name of the contact [e.g. a target of a promoter] in a network address [e.g. URL or IP address, e.g. page 4, lines 17-26] associated with the cause; and

including the network address [e.g. URL or IP address, e.g. page 4, lines 17-26] in

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material sent to the contact [e.g. a target of a promoter].

Claim 43 A method of conducting a promotion [e.g. advertising initiative], the method comprising:

including a name of the promotion [e.g. advertising initiative] in a network address [e.g. URL or IP address, e.g. page 4, lines 17-26] associated with the promotion [e.g. advertising initiative]; and broadcasting the networks address [e.g. URL or IP address, e.g. page 4, lines 17-26] to a plurality of targets.

Claim 45 A computer-readable medium bearing promotion [e.g. advertising initiative] information for use by one or more processors that are participating in providing resources [e.g. files or service, e.g. page 6, lines 13-18] on a network [e.g. network 210 of Figure 2], the promotion [e.g. advertising initiative] information comprising:

contact information about a contact [e.g. a target of a promoter] to receive materials as part of a promotion [e.g. advertising initiative]; and

a resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] indicating where the resource [e.g. files or service, e.g. pages 13-18] can be accessed on the network [e.g. network 210 of Figure 2], the resource location information [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] including information from the contact information.

Claim 46 A computer program product for inducing a contact [e.g. a target of a promoter] to invoke a resource [e.g. files or service, e.g. page 6, lines 13-18] prepared by a promoter [e.g. a person desiring to reach targets, e.g. page 7, line 15] on a network [e.g. network 210 of Figure 2], the computer program product comprising:

a computer readable medium;

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instructions residing on the computer readable medium for causing one or more processors to generate a resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] for the resource [e.g. files or service, e.g. page 6, lines 13-18], the resource location description including a name of the contact [e.g. Figure 5A, columns 552,554]; provide access to the resource [e.g. files or service, e.g. page 6, lines 13-18] at a location on the network [e.g. network 210 of Figure 2] according to the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21]; and prepare a message notifying the contact [e.g. a target of a promoter] about the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] for the resource [e.g. files or service, e.g. page 6, lines 13-18].

Claim 51 A computer program product for inducing a contact [e.g. a target of a promoter] to visit a web site [e.g. a server running on a device, e.g. page 10, lines 12-13] prepared by a promoter [e.g. a person desiring to reach targets, e.g. page 7, line 15], the computer program product comprising:

a computer readable medium; and
instructions residing on the computer readable medium for causing one or more processors to generate a host-name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3, e.g. Figure 5A, column 562] for the web site [e.g. a server running on a device, e.g. page 10, lines 12-13], the host name including a name of the contact [e.g. a target of a promoter], prepare a message notifying the contact [e.g. a target of a promoter] of the host name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3, e.g. Figure 5A, column 562] for the web site [e.g. a server running on a device, e.g. page 10, lines 12-13], and configure a web server [e.g. a server

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running on a device, e.g. page 10, lines 12-13] at the web site [e.g. a server running on a device, e.g. page 10, lines 12-13] to process a request including the host name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3, e.g. Figure 5A, column 562].

Claim 62 A computer program product of promoting a cause to a contact [e.g. a target of a promoter], the computer program product comprising:

a computer readable medium; and instructions residing on the computer readable medium for causing one or more processors to include a name of the contact [e.g. Figure 5A, columns 552-554] in a network address [e.g. URL or IP address, e.g. page 4, lines 17-26] associated with the cause; and include the network address [e.g. URL or IP address, e.g. page 4, lines 17-26] in a message prepared for the contact [e.g. a target of a promoter].

Claim 63 A computer program product of conducting a promotion, the computer program product comprising:

a computer readable medium; and instructions residing on the computer readable medium for causing one or more processors to include a name of the promotion in a network address [e.g. URL or IP address, e.g. page 4, lines 17-26] associated with the promotion; and prepare a message including the network address [e.g. URL or IP address, e.g. page 4, lines 17-26] for broadcast to a plurality of targets.

Dependent Claims:

Claim 10 The method of claim 1, wherein: the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] includes a directory name; and

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 said generating comprises using the contact [e.g. a target of a promoter] name in the directory name [e.g. a level if a file hierarchy].

Claim 11 The method of claim 1, wherein: the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] includes a host name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3, e.g. Figure 5A, column 562]; and

 said generating comprises using the contact [e.g. a target of a promoter] name in the host name [e.g. portion of a domain name to the left of the Top Level Domain (TLD) name, e.g. page 4, lines 1-3, e.g. Figure 5A, column 562].

Claim 12 The method of claim 8, said generating further comprising making the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] unique among a plurality of other resource location descriptions [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] corresponding to the plurality of contacts [e.g. a target of a promoter].

Claim 13 The method of claim 12, said generating further comprising, if an original first name of the name of the contact [e.g. Figure 5A, columns 552, 554] does not make the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] unique, changing the original first name to one of an initial and a nickname.

Claim 14 The method of claim 12, said generating further comprising, if an original first name of the name of the contact [e.g. Figure 5A, columns 552, 554] does not make the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] unique, changing a connecting character between the first name and a second name of the name of the contact [e.g. a target of a

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[promoter] to at least one of a different connecting character and a different number of the connecting character.

Claim 15 The method of claim 12, said generating further comprising, if an original name of the contact [e.g. Figure 5A, columns 552, 554] does not make the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] unique, adding additional characters based on other information from the contact database associated with the contact [e.g. a target of a promoter].

Claim 16 The method of claim 7, said generating further comprising, if an original name of the contact [e.g. Figure 5A, columns 552, 554] includes a character prohibited for a resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21], changing the prohibited character to an allowed character.

Claim 18 The method of claim 1, further comprising terminating access to the resource [e.g. Figure 3B, item 390, e.g. files or service, e.g. page 6, lines 13-18] at the location when a promotion [e.g. advertising initiative] associated with the resource [e.g. files or service, e.g. page 6, lines 13-18] ends.

Claim 19 The method of claim 1, further comprising changing content in the resource [e.g. files or service, e.g. page 6, lines 13-18] when a promotion [e.g. advertising initiative] associated with the resource [e.g. files or service, e.g. page 6, lines 13-18] reaches a predetermined stage.

Claim 20 The method of claim 6, further comprising repeating said notifying the contact [e.g. a target of a promoter] when a promotion [e.g. advertising initiative] associated with the resource [e.g. files or service, e.g. page 6, lines 13-18] reaches a

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predetermined stage and the activity logged is less than a predetermined threshold of activity.

Claim 23 The method of claim 8, said generating further comprising making a subdomain name in the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] unique among a plurality of other document location descriptions corresponding to the plurality of contacts [e.g. a target of a promoter] and sharing a common higher level domain name.

Claim 49 The computer program product of claim 48, the instructions to generate the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] further comprising instructions to use a subdomain name in the resource location description [e.g. Uniform Resource Locator or URL, e.g. page 6, lines 18-21] with a different higher level domain name, if the subdomain name is not unique within one higher level domain name.

Claim 50 The computer program product of claim 46, the instructions further configuring the one or more processors to terminate access to the resource [e.g. Figure 3B, item 390, e.g. files or service, e.g. page 6, lines 13-18] at the location when a promotion [e.g. advertising initiative] associated with the resource ends."

Issues to be Reviewed on Appeal

The grounds of rejection to be reviewed on this appeal are:

Issue 1. Whether the Examiner erred in rejecting claims 1-5, 7-12, 17, 23, 25, 27-28, 31-33, 42-43, 45-48, 51-53 and 62-63 under 35 U.S.C. § 103(a) as obvious over Shane (U.S. Patent No. 5,793,972, hereinafter, Shane). Note that in the Final rejection the Examiner listed the patent number as 5,752,022 which was the patent number of a reference involved in a previous rejection

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which has now been withdrawn. The number listed is believed to be the correct number for the Shane reference.

Issue 2. Whether the Examiner erred in rejecting claims 6, 13-16, 18-22, 24, 26, 29-30 and 49-50 under 35 U.S.C. § 103(a) as unpatentable over Shane in view of LeMole et al. (U.S. Patent No. 6,009,410, hereinafter LeMole).

Issue 3. Whether the Examiner erred in rejecting claims 45-53 and 62-63 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Argument

Issue 1: The Examiner erred in rejecting claims 1-5, 7-12, 17, 23, 25, 27-28, 31-33, 42-43, 45-48, 51-53 and 62-3 under 35 U.S.C. § 103(a) as obvious over Shane.

The Shane reference does not utilize the name of a contact in a Uniform Resource Locator (URL). There is no teaching or suggestion in Shane to utilize the name of the contact as part of a URL. Each of the claims remaining in this application explicitly require the use of the name of the contact, with the exception of claims 43, 45 and 63. Therefore, the Shane reference does not anticipate any of claims 1-5, 7-12, 17, 23, 25, 27-28, 31-33, 42, 46-48, 51-53 and 62 under 35 U.S.C. § 102. Those claims are also not obvious under 35 U.S.C. § 103 as discussed more hereinafter.

Independent claims 43 and 63 require that the Uniform Resource Locator include the "name of the promotion" in a network address. This is also not taught or suggested by Shane. Accordingly, claims 43 and 63 are also not anticipated by Shane.

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Again, the Examiner has made no argument that these claims are unpatentable under 35 U.S.C. § 103.

Claim 45 is a computer program product claim in which the computer readable medium includes contact information about a contact and a resource location description indicating where the resource can be accessed on the network, in which the "location information" includes information from the contact information. Since Shane does not disclose a computer readable medium that has the information described in claim 45, Shane does not anticipate claim 45 under 35 U.S.C. § 102. Again, the Examiner has failed to argue that any differences between claim 45 and the Shane reference would have been obvious.

Turning to dependent claim 10, the Examiner has made no showing of a teaching or suggestion to utilize the contact name in a directory name. Accordingly, this claim is not anticipated by Shane.

With respect to claim 11, the Examiner has made no showing that the step of generating comprises using the contact name in the host name. There is no showing in Shane of using a contact name in the host name.

Turning to claim 12, which is dependent upon claim 8, the Examiner has not pointed out any teaching or suggestion of making the resource location description unique among a plurality of other resource location descriptions, such as might occur when a name is otherwise redundant when included with a host name.

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With respect to claim 23, the Examiner has not provided any teaching or suggestion for the Shane reference that would suggest causing a sub-domain name to be unique. Accordingly, these dependent claims are not anticipated by the Shane reference. The dependent claims are also not anticipated by the Shane reference for the reasons given with respect to the independent claims.

The Examiner has made no analysis of the differences between Shane and the claimed invention, and particularly why it would be "obvious" to use a contact name in lieu of the personal identification code taught by Shane. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. See the discussion of Issue 2, below for more arguments on obviousness.

Accordingly, none of the claims remaining in the application are anticipated or rendered obvious by Shane. Accordingly, since Shane does not disclose all limitations from each of the claims under rejection nor does the Examiner argue their obviousness, a rejection under either 35 U.S.C. § 102 or 103 is not proper. Accordingly, the rejection under 35 U.S.C. § 103 should be reversed.

Issue 2: The Examiner erred in rejecting claim 6, 13, 16, 18, 22, 24, 26, 29-30 and 49-50 are under 35 U.S.C. § 103(a) as unpatentable over Shane in view of LeMole.

Each of claims 6, 13-16, 18-22, 24, 26, 29-30 and 49-50 are dependent claims. Claim 6, 13-16, 18-22, 24, 26, and 29-30 are

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each directly or indirectly dependent upon claim 1. Claims 49 and 50 are directly or indirectly dependent upon independent claim 46. Both independent claims 1 and 46 contain a requirement that the resource location description include a name of the contact being targeted by the direct mailing. As pointed out in the Declaration under 37 C.F.R. § 1.132 filed with the Amendment of October 14, 2005, a copy of which is attached in the evidence Appendix to this Appeal Brief, the use of the contact's name results in unexpectedly superior returns in response to a direct contact initiative such as a direct mailing.

The Shane reference utilizes a unique "personal identification code for a recipient." An example of that unique identification code is shown in Figure 2, item 56 of Shane. This code is definitely not a name and there is no teaching or suggestion in the Shane reference of using a name.

Shane acknowledges the existence of a problem with response rates. At column 2, beginning line 1, Shane notes that:

"However, conventional direct mail has certain limitations. A one percent (1%) response rate is considered a success."

As shown by the Declaration attached hereto as Exhibit B, the use of the name in the Uniform Resource Locator, as opposed to some meaningless personal identification code provides significantly improved response rate. Each of the claims except claims 43 and 45 contain such a limitation and therefore accordingly, provide an improved result over the prior art, such as Shane. Since Shane provides no teaching or suggestion of using the name of the contact in the Uniform Resource Locator and since using the name provides substantially improved

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response, The Board is respectfully requested to reverse the rejection.

With respect to claim 43, the Shane reference does not teach or suggest inclusion of a "name of the promotion in a network address"

With respect to claim 45, the Shane reference does not disclose "a resource location description... including information from the contact information."

Accordingly, each of the independent claims distinguishes over the Shane reference.

Turning to the dependent claims, claim 13, which is dependent upon claim 12, describes a particular technique for making the resource location description unique. Specifically, it changes the original first name to one of an initial and a nickname. This is not taught or suggested by Shane nor any of the other references provided by the Examiner. Further, the Examiner has not made an argument for obviousness of this technique.

Claim 14 which is also dependent upon claim 12, describes yet another technique for making the uniform resource location description unique. In this claim, it involves changing a connecting character between the first name and the second name of the contact when that name is utilized in the resource location description. None of the references cited by the Examiner teach or suggest this technique.

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Claim 15 is also dependent upon claim 12, and shows yet another technique for making the resource location description unique by adding additional characters based on other information from the contact database associated with the contact. None of the references teach or suggest this approach.

Claim 16, which is dependent upon claim 7, provides a way of dealing with contact names that contain characters prohibited from use in a resource location description. This problem has not been recognized by the references because the references do not utilize the name of the contact. Further, claim 16 fixes the problem by changing the prohibited character to an allowed character.

Claims 18 and 50 refer to terminating access to the resource when a promotion ends. The Examiner has not pointed out any teaching or suggestion in the references applied against the claims where this is done. Accordingly, claims 18 and 50 distinguish over the prior art.

Claim 19 recites changing the content of the resource when a promotion reaches a predetermined stage. The Examiner has not pointed out where any of the references applied against the claims teach or suggest this limitation.

Claim 20 recites notifying the contact when a promotion reaches a predetermined stage and the activity logged is less than a particular threshold. Again, this is not taught or suggested by the references applied by the Examiner.

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Claim 49 is also directed toward insuring uniqueness in resource location description. In this technique, a sub-domain name will be associated with a different higher level domain name if for some reason the sub-domain name is not unique within one higher level of a domain name hierarchy. Again, the references do not teach or suggest this limitation.

The LeMole patent is directed to a customized advertising repository server. A user can access that server through a browser and enter a profile, such as a profile describing advertising subjects in which the user is interested. When a user accesses his or her customized advertising repository through the browser, a composite advertising page is dynamically configured by the customized advertising repository server for that particular user based on that user's previously provided user profile.

There is no teaching or suggestion on LeMole for including in a resource location description the name of the contact to which promotional material is to be sent. Rather, a user must volunteer to receive advertising by creating a profile in the customized advertising repository server. Further, there is no need to notify a contact about the resource location description for the resource, since, in the LeMole patent, the user already knows the description of the customized advertising repository server, since the user has utilized that location to create his profile and must log into it to get his pre-specified advertising.

With respect to each of the claims rejected under 35 U.S.C. § 103, the Examiner has failed to establish a motivation or

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suggestion for combining any particular teaching of the LeMole reference with the Shane reference. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

In the Final Rejection, the Examiner has taken the position that certain items of which he/she took "official notice" were conclusively established because Applicant had failed to seasonably challenge the Examiner's assertions. The Examiner held that a "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response.

The first time Applicant raised the "official notice" issue in the context of a rejection based in Shane in view of LeMole, was in the Office Action of July 14, 2005. In the Amendment filed October 14, 2005, in response to that Office Action, Applicants traversed the propriety of taking official notice. There, Applicants stated:

"On page 6 of the Office Action, the Examiner has asserted that certain limitations are "well known" (second full paragraph) or the subject of "official notice" (last seven lines on page 6).

The Examiner has failed to show a rationale or teaching in the LeMole et al. or in the prior art that would suggest the limitation of LeMole et al. will be combined with Shane. With respect to the "well known" activity, the Examiner is merely assuming that the limitation that he cannot find in the prior art is well known and then leverages off that assumption to the conclusion that the limitations would have been obvious. Again, the Examiner has failed to make a *prima facie* case of obviousness.

With respect to the "official notice" the Examiner has failed to establish that this is sufficiently well known, that it would be a

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suitable subject matter for official notice. Accordingly, the Examiner has failed to establish a prima facie case of obviousness."

In context, Applicant clearly traversed the propriety of the holding of "official notice" in a timely fashion. Further, Applicant's statement that "the Examiner has failed to establish that this sufficiently well known, that it would be a suitable subject matter for official notice" can only be construed as a request for evidence. Accordingly, the Examiner's attempt to preclude any challenge to his/her self-serving determination of official notice constitutes an abuse of discretion.

The Examiner originally held that the Declaration under 37 C.F.R. § 1.132 included in the evidence Appendix to this Brief, did not apply to a rejection under 35 U.S.C. § 102. However, the Examiner has now changed the rejection to one under 35 U.S.C. § 103. Accordingly, even though the Examiner conveniently mislabels a rejection as one under 35 U.S.C. § 102, it is really under 35 U.S.C. § 103 because the Examiner has failed to establish that the reference contains each and every element that is in the claims. Accordingly, the Declaration under 37 C.F.R. § 1.132 does appropriately apply to each of the independent claims to the extent that they include the "name of the contact" limitation.

Accordingly, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejections under 35 U.S.C. § 103.

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Issue 3: The Examiner erred in rejecting claims 45-53 and 62-63 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

In rejecting claims 45-53 and 62-63 under 35 U.S.C. § 101, the Examiner stated:

"Claims 45-53 and 62-63 [sic-are] rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The claimed "computer-readable medium" is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 18, line 10, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAM, ROM, CD-ROM, disks, etc.) and intangible embodiments (e.g., carrier waves). As such, the claim is not limited to statutory subject matter and is therefore non-statutory."

Claims 45-53 and 62-63 are Beauregard claims (*In re Beauregard*, 353 F.3d 1583; 35 USPQ.2d 1383 (Fed. Cir. 1995). MPEP § 2106.01(Eight Edition, section V) requires Beauregard claims to be given statutory weight:

"...[A] claimed **computer-readable medium encoded with a data structure** defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structures functionality to be realized, **and is thus statutory.**"

The Examiner asserts that the "medium" is not limited to tangible embodiments and cites as an example "carrier waves." The word tangible means "capable of being appraised at an actual or approximate value" and has as a synonym, "perceptible." See, for example, the Merriam Webster On-line Dictionary.

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A carrier wave is in fact perceptible. That is true whether or not it is in the optical domain or in the radio frequency domain or in the subsonic frequency domain. It can be perceived with appropriate instrumentation. A carrier wave has nothing to do with being abstract in the sense of 35 U.S.C. § 101. The final version of the Examination Guidelines For Computer-Related Inventions issued by the Patent and Trademark Office does not contain a discussion of "carrier waves" whereas, in previous discussions of statutory subject matter those were of some concern. Accordingly, the Examiner has failed to establish a *prima facie* case of non-statutory subject matter. Accordingly, Applicant respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's rejections under 35 U.S.C. § 101.

Conclusions

For the reasons indicated, the Examiner has failed to establish a *prima facie* case of anticipation over the Shane reference and has failed to establish a *prima facie* case of obviousness either over Shane alone or in view of Shane in view of LeMole. Accordingly, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's rejections.

The Commissioner is authorized to charge or credit any

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discrepancies in fee amounts to Deposit Account No. **01-0484.**

Respectfully submitted,



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APPENDIX A - CLAIMS ON APPEAL
FOR U.S. PATENT APPLICATION SERIAL
NO. 09/513,845

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HAUGLAND ET AL.
Serial No. **09/513,845**
Filed: **FEBRUARY 25, 2000**

APPENDIX A - CLAIMS ON APPEAL
FOR U.S. PATENT APPLICATION SERIAL NO. 09/513,845

Claim 1 (original) A method for inducing a contact to invoke a resource prepared by a promoter on a network, the method comprising:

generating a resource location description for the resource by the promoter, the resource location description including a name of the contact;

providing access to the resource at a location on the network according to the resource location description; and

notifying the contact about the resource location description for the resource.

Claim 2 (original) The method of claim 1, further comprising tailoring content in the resource in response to the resource location description used to access the resource.

Claim 3 (original) The method of claim 1, said providing access to the resource at the location comprising placing the resource at the location.

Claim 4 (original) The method of claim 1, said providing access to the resource at the location comprising configuring an operating system to divert a request for the resource at the location to a second location where the resource resides.

Claim 5 (original) The method of claim 1, wherein: a request for the resource includes the resource location description; and the method further comprises generating content for the document dynamically in response to the

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resource location description in the request.

Claim 6 (original) The method of claim 1, further comprising:

logging activity involving the resource; and changing content in the resource in response to the activity logged.

Claim 7 (original) The method of claim 1, further comprising:

setting up a contact database; and automatically retrieving the contact name from the contact database before said generating the resource location description.

Claim 8 (original) The method of claim 7, further comprising repeating said steps of generating the resource location description, providing access, and notifying the contact for a plurality of contacts from the contact database.

Claim 9 (original) The method of claim 1, wherein the resource location description is a universal resource locator address.

Claim 10 (original) The method of claim 1, wherein: the resource location description includes a directory name; and said generating comprises using the contact name in the directory name.

Claim 11 (original) The method of claim 1, wherein: the resource location description includes a host name; and said generating comprises using the contact name in the

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host name.

Claim 12 (original) The method of claim 8, said generating further comprising making the resource location description unique among a plurality of other resource location descriptions corresponding to the plurality of contacts.

Claim 13 (original) The method of claim 12, said generating further comprising, if an original first name of the name of the contact does not make the resource location description unique, changing the original first name to one of an initial and a nickname.

Claim 14 (original) The method of claim 12, said generating further comprising, if an original first name of the name of the contact does not make the resource location description unique, changing a connecting character between the first name and a second name of the name of the contact to at least one of a different connecting character and a different number of the connecting character.

Claim 15 (original) The method of claim 12, said generating further comprising, if an original name of the contact does not make the resource location description unique, adding additional characters based on other information from the contact database associated with the contact.

Claim 16 (original) The method of claim 7, said generating further comprising, if an original name of the

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contact includes a character prohibited for a resource location description, changing the prohibited character to an allowed character.

Claim 17 (original) The method of claim 11, further comprising updating a domain name file to include the host name for use by a domain name server.

Claim 18 (original) The method of claim 1, further comprising terminating access to the resource at the location when a promotion associated with the resource ends.

Claim 19 (original) The method of claim 1, further comprising changing content in the resource when a promotion associated with the resource reaches a predetermined stage.

Claim 20 (original) The method of claim 6, further comprising repeating said notifying the contact when a promotion associated with the resource reaches a predetermined stage and the activity logged is less than a predetermined threshold of activity.

Claim 21 (original) The method of claim 20, wherein the predetermined threshold of activity is one request for the resource.

Claim 22 (original) The method of claim 20, wherein the predetermined threshold of activity is one payment in response to an offer presented by invoking the resource.

Claim 23 (original) The method of claim 8, said

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generating further comprising making a subdomain name in the resource location description unique among a plurality of other document location descriptions corresponding to the plurality of contacts and sharing a common higher level domain name.

Claim 24 (original) The method of claim 8, said generating further comprising, if a subdomain name in the resource location description is not unique within one higher level domain name, then using the subdomain name with a different higher level domain name.

Claim 25 (original) The method of claim 2, said tailoring further comprising including information associated with the contact in a contact database into the content of the resource.

Claim 26 (original) The method of claim 2, said tailoring further comprising selecting alternative resource content elements into the content of the resource based on information associated with the contact in a contact database

Claim 27 (original) The method of claim 1, further comprising denying access to the resource if a request for the resource does not include a predetermined authentication.

Claim 28 (original) The method of claim 1, further comprising dynamically tailoring content in the resource in response to authentication in a request for the resource.

Claim 29 (original) The method of claim 6, further

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comprising launching a credit card purchase process in response to the activity logged.

Claim 30 (original) The method of claim 29, said launching a credit card purchase process further comprising:

directing a user acting on the document to a secure socket layer server;

obtaining credit card information from the user by the secure socket layer server; and sending the credit card information to a fulfillment house from the secure socket layer over a virtual private network link.

Claim 31 (original) A method for inducing a contact to visit a web site prepared by a promoter, the method comprising:

generating a host name for the web site by the promoter, the host name including a name of the contact;

notifying the contact of the host name for the web site; and

configuring a web server at the web site to process a request including the host name.

Claim 32 (original) The method of claim 31, the step of configuring further comprising treating requests as visits to a persistent web site belonging to the contact.

Claim 33 (original) The method of claim 32, wherein:

the method further comprises receiving content for the persistent web site from the contact; and

the step of configuring further comprises presenting content from the contact in response to the request.

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Claim 34 (cancelled)

Claim 35 (cancelled)

Claim 36 (cancelled)

Claim 37 (cancelled)

Claim 38 (cancelled)

Claim 39 (cancelled)

Claim 40 (cancelled)

Claim 41 (cancelled)

Claim 42 (original) A method of promoting a cause to a contact, the method comprising:

including a name of the contact in a network address associated with the cause; and

including the network address in material sent to the contact.

Claim 43 (original) A method of conducting a promotion, the method comprising:

including a name of the promotion in a network address associated with the promotion; and broadcasting the networks address to a plurality of targets.

Claim 44 (cancelled)

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Claim 45 (original) A computer-readable medium bearing promotion information for use by one or more processors that are participating in providing resources on a network, the promotion information comprising:

contact information about a contact to receive materials as part of a promotion; and

a resource location description indicating where the resource can be accessed on the network, the resource location information including information from the contact information.

Claim 46 (original) A computer program product for inducing a contact to invoke a resource prepared by a promoter on a network, the computer program product comprising:

a computer readable medium;
instructions residing on the computer readable medium for causing one or more processors to generate a resource location description for the resource, the resource location description including a name of the contact; provide access to the resource at a location on the network according to the resource location description; and prepare a message notifying the contact about the resource location description for the resource.

Claim 47 (original) The computer program product of claim 46, the instructions further configuring the one or more processors to automatically retrieve the contact name from a contact database including information about a plurality of contacts before the one or more processors generate the resource location description.

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Claim 48 (original) The computer program product of claim 47, the instructions further configuring the one or more processors to repeatedly generate the resource location description, provide access, and prepare message for a plurality of contacts from the contact database.

Claim 49 (original) The computer program product of claim 48, the instructions to generate the resource location description further comprising instructions to use a subdomain name in the resource location description with a different higher level domain name, if the subdomain name is not unique within one higher level domain name.

Claim 50 (original) The computer program product of claim 46, the instructions further configuring the one or more processors to terminate access to the resource at the location when a promotion associated with the resource ends.

Claim 51 (original) A computer program product for inducing a contact to visit a web site prepared by a promoter, the computer program product comprising:

a computer readable medium; and

instructions residing on the computer readable medium for causing one or more processors to generate a host-name for the web site, the host name including a name of the contact, prepare a message notifying the contact of the host name for the web site, and configure a web server at the web site to process a request including the host name.

Claim 52 (original) The computer program product of claim

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51, the instructions to configure further comprising instructions to treat requests as visits to a persistent web site belonging to the contact.

Claim 53 (original) The computer program product of claim 52, wherein:

the instructions further comprises instructions causing the one or more processors to receive content for the persistent web site from the contact; and the instructions to configure the web site further comprise instructions to present content from the contact in response to the request.

Claim 54 (cancelled)

Claim 55 (cancelled)

Claim 56 (cancelled)

Claim 57 (cancelled)

Claim 58 (cancelled)

Claim 59 (cancelled)

Claim 60 (cancelled)

Claim 61 (cancelled)

Claim 62 (original) A computer program product of promoting a cause to a contact, the computer program product comprising:

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a computer readable medium; and
instructions residing on the computer readable medium for
causing one or more processors to include a name of the
contact in a network address associated with the cause; and
include the network address in a message prepared for the
contact.

Claim 63 (original) A computer program product of
conducting a promotion, the computer program product
comprising:

a computer readable medium; and
instructions residing on the computer readable medium for
causing one or more processors to include a name of the
promotion in a network address associated with the promotion;
and prepare a message including the network address for
broadcast to a plurality of targets.

Claim 64 (cancelled)

Claim 65 (cancelled)

Claim 66 (cancelled)

Claim 67 (cancelled)

Claim 68 (cancelled)

Claim 69 (cancelled)

Claim 70 (cancelled)

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Claim 71 (cancelled)

Claim 72 (cancelled)

Claim 73 (cancelled)

Claim 74 (cancelled)

Claim 75 (cancelled)

Claim 76 (cancelled)

Claim 77 (cancelled)

Claim 78 (cancelled)

APPENDIX B - EVIDENCE APPENDIX
PURSUANT TO 37 C.F.R. §
41.37(c)(1)(ix)

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APPENDIX B - EVIDENCE APPENDIX
PURSUANT TO 37 C.F.R. § 41.37(c)(1)(ix)

The attached Declaration under 37 C.F.R. § 1.132 was considered by the Examiner when evaluating the Office Action received on July 14, 2005.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
HAUGLAND ET AL.)
Serial No. 09/513,845)
Filing Date: FEBRUARY 25, 2000)
For: MASS GENERATION OF VIRTUAL)
SOURCES, VIRTUAL WEB SITES AND)
VIRTUAL WEB OBJECTS)

Attorney Docket No: 81301
Examiner: K. FLYNN
Art Unit: 2153
Date Submitted: OCT 14 2005

DECLARATION OF HENRY HAUGLAND

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Henry Haugland, do hereby depose and say:

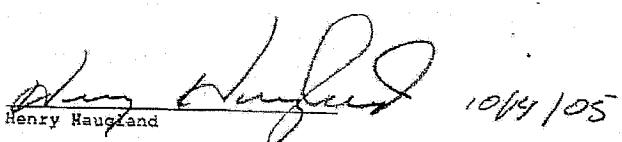
1. That I am president of Webreply.Com, a direct mail service provider;
2. That for the past several years we have conducted direct mail campaigns and I am intimately familiar with the issues of response rate to direct mail campaigns;
3. That I am conversant with U.S. Patent 5,793,972 to Shane;
4. That Shane does not teach or suggest the use of a contact's name in the Uniform Resource Locator as described and claimed in the above-identified application;

5. That, I have conducted comparative tests comparing the response rates received when utilizing the name of the contact in the Uniform Resource Locator as claimed in the above-identified application with the response rate received when the name was not so used;
6. That in one test, for example, I created two test cell derived from a list of 20,000 names with names randomly assigned to either test cell "A" or test cell "B". The cell "A" URL's were of the form
www.firstname.lastname.niku.net. The cell "B" URL's were of the form www.info.niku.net.
7. That when this test was conducted, the click through rate for members of the type "A" cell was 16% (where the name of the contact was used) whereas the click through rate for members of cell "B" was only 1.5%.
8. That thus, the response rate using the contacts name as required in the claims in the above-identified application was more than ten times better than the response rate when the contact name was not utilized.
9. That thus, the use of the claimed invention results in a ten-fold increase over the "one percent (1%) response rate... considered a

success" (column 2, line 2) as taught by the
Shane reference.

And further deponent sayith not.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Henry Haugland 10/14/05

APPENDIX C - RELATED PROCEEDINGS

APPENDIX

PURSUANT TO 37 C.F.R. §

41.37(c)(1)(x)

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APPENDIX C - RELATED PROCEEDINGS APPENDIX
PURSUANT TO 37 C.F.R. § 41.37(c)(1)(x)

None.

APPENDIX D – CERTIFICATE OF SERVICE

In re Patent Application of:
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Filed: **FEBRUARY 25, 2000**

APPENDIX D - CERTIFICATE OF SERVICE

None.